



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,282	07/22/2003	Frederick G. Payne	54593-2	7900
23994 7590 04/13/2007 JOSEPH W MOTT JENNINGS STROUSS & SALMON PLC 201 EAST WASHINGTON STREET 11TH FLOOR PHOENIX, AZ 85004-2385			EXAMINER KATCHEVES, BASIL S	
			ART UNIT 3635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/13/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/625,282

Applicant(s)

PAYNE, FREDERICK G.

Examiner

Basil Katcheves

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,269,008 to Assouline as in the previous action.**

Regarding claim 1, Assouline discloses a method of discouraging roosting comprising identifying a roosting zone (abstract) and applying a slide (Flat surfaces at fig. 1: 7 and fig. 4: 2) sheet which comprises angled slick outer faces (4). Regarding the “formed” limitation, applicant should note that determination of patentability is based on the method itself. The patentability of a method does not depend on an article's method of production (in this case “formed”). If the article in the method claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Regarding claim 2, Assouline discloses the slide as being a peaked polyhedron (claim 1).

Regarding claim 3, Assouline discloses the slide as a triangular prism.

Regarding claim 4, Assouline discloses the slide as being a pyramid.

Art Unit: 3635

Regarding claim 5, Assouline discloses a triangular prism, the side affixed to the roosting zone is partially open (fig. 4: area between slides), and the slide across section is an inverted "V" (fig. 2: 4, inverted V profile).

Regarding claim 10, Assouline discloses a partial pyramid (fig. 1: see top portion 5 and angled surfaces of pyramid which if extended to base 7 would be angled, not straight as 3 is, therefore disclosing the top portion of a pyramid and not the entire pyramid).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,269,008 to Assouline as in the previous action.**

Regarding claim 11, Assouline discloses a method of discouraging roosting comprising identifying a roosting zone (abstract) and applying a slide (Flat surfaces at fig. 1: 7 and fig. 4: 2) sheet which comprises angled slick outer faces (4). Assouline discloses the basic claim structure of the instant application but does not disclose

Art Unit: 3635

angled dimensions as following roof slopes. Applicant fails to show criticality for specifically claimed slopes, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims since Assouline discloses the use of differing slopes (fig. 2: 4' and 4").

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,269,008 to Assouline in view of U.S. Patent No. 6,546,676 to Wiesener et al as in the previous action.**

Assouline does not disclose silicone applied along a periphery to fasten the object. Wiesener discloses a bird repelling device secured to a structure through the use of a silicone adhesive (column 3, lines 14-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Assouline by adding silicone adhesive, as disclosed by Wiesener, along the periphery of the device in order to create a weather resistant seal in order to prevent water from entering the underside of the device and rotting the material beneath.

### ***Response to Arguments***

Applicant's arguments filed 1/31/07 have been fully considered but are moot under new grounds of rejections. The applicant argues that the prior art (Assouline) teaches away from applying a slide and instead teaches the application of polyhedrons. However, the applicant should note that the limitation of a slide is something which may aid sliding upon. Since Assouline teaches a device for keeping birds away, and that device includes a plurality of angled surfaces, if a bird were to land upon one of these

angles surfaces, the bird would, in fact, slide downward. This is an inherent property of an angled surface such as that of Assouline. The applicant states that the intent of Assouline is to use the polyhedron shape to scare birds. The applicant should note that the invention of Assouline is not limited to only the intended use. Structurally, Assouline provides a surface which can cause sliding, thus meeting the claimed structural limitation of the instant application. The applicant also argues that slide sheets (fig. 1: 7) are not slide sheets. As applied to the instant application, the applicant claims, in claim 1, a formed sheet having slide surfaces. The sheet, in the rejection above, being 7 and the slide surfaces being 4. Applicant argues that birds cannot stand on the flat portion 7. However, the applicant should note that fig. 2 (and better seen in fig. 3) is a one piece unit. The sheet comprises horizontal flats, vertical flats, and diagonal flats having various angles. Also, the applicant argues the limitation "slick". The limitation of slick is something which can aid in sliding. This being a diagonally sloped surface. The surface of Assouline meets the limitations and may be considered as being "slick". The applicant also argues the invention of Assouline is to visually deter birds. This limitation does not limit the prior art to a single function. The prior art may inherently perform functions allowable by it's physical structure. The applicant argues the structure of Assouline is not a triangular prism. A reasonable interpretation of this shape is a prism, anything shaped to break down the light spectrum, with the shape of a triangle. This is met by a pyramidal shape as that of Assouline (4). This pyramidal structure of Assouline also meets the limitations of claims 4 and 10, being a pyramid. The applicant argues that the slope of Assouline is not that of a roof nor is it obvious to do so.

Art Unit: 3635

However, the applicant should note that slight modifications in dimensions without changing the scope or effectiveness of the invention is an obvious choice. Also, the applicant should note that there is no roof claimed in the invention. The claim compares a slope of an article claimed to the slope of an object not being claimed and therefore, the object not claimed has no limitations. Applicant also argues the combination of Wiesener to use a sealant. The use of sealant is well known in the art of outdoor (and indoor as well) construction. The applicant argues there is no need to keep water off of the roof slope. However, the roof slope is in direct contact with falling rain and would have a need to for a water resistant seal.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 3635

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (571) 272-6842.

BK *[Signature]*

4/5/07

  
Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600